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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,847	10/30/2003	Arkady Glukhovsky	P-5476-US	8263
49443	7590	05/11/2006	EXAMINER	
PEARL COHEN ZEDEK, LLP 1500 BROADWAY 12TH FLOOR NEW YORK, NY 10036			SMITH, PHILIP ROBERT	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,847

Applicant(s)

GLUKHOVSKY ET AL.

Examiner

Philip R. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 9, 11, 22-24, 26, 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 10, 12-21, 25, 27-30 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Restriction

- [01] Claims 5-7, 9, 11, 22-24, 26, 31 & 32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/5/2006.

Claim Rejections - 35 USC § 102

- [02] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [03] Claims 1-4, 8, 10, 12-18, 20-21, 25, 27-30 & 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Denen (5,400,267).
- [04] With regard to claims 1 & 20: The in vivo device disclosed by Denen ("medical equipment 31") is inherently swallowable. It further comprises an internal battery ("battery backed-up random access memory (RAM)," 5/8).
- [05] Claims 2-4, 8, 10, 12-13, 17-21, 25, 27-30 & 33 are anticipated by Denen as set forth in the Office action of 6/22/2005.
- [06] With regard to claims 14-16: The circuit to prevent reactivation disclosed by Denen is non-volatile, as noted in the Office action of 6/22/2005.

Claim Rejections - 35 USC § 103

- [07] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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[08] Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denen in view of Kane (6,204,746), as set forth in the Office action of 6/22/2005.

Response to Arguments

[09] Applicant's arguments filed 12/20/2005 have been fully considered but they are not persuasive.

[10] Applicant asserts that "Denen does not teach or describe a swallowable in vivo device." On the contrary, the medical device is at least partially swallowable as prescribed; potentially swallowable in full as prescribed; and certainly swallowable by, for example, a shark.

[11] Applicant contends that "[t]he memory [disclosed by Denen] is not part of the blocking process, such blocking process in Denen being done by the external controller." As noted in the Office action of 6/22/2005, the operation blocker and circuit which prevents reactivation of said in vivo sensing device is anticipated by "control module 36" & "non-volatile memory 30" for storing "utilization history" ([07], Office action of 6/22/2005). Contrary to Applicant's contention, it is clear from Denen's disclosure that the memory is in fact part of the blocking process, in that it stores the utilization history which is essential to the prevention of activation. Given that the non-volatile memory is essential to the operation blocker disclosed by Denen, claim 14 is anticipated as indicated in the Office action of 6/22/2005.

[12] Applicant further contends that "Denen does not teach or suggest preventing the operation of said autonomous in-vivo sensing device upon the satisfaction of a

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specified condition." For the reasons set forth in the Office action of 6/22/2005, it is maintained that Denen anticipates such a method step. To support this contention, Applicant states that "the controller of the invention in Denen is consistently described as external." If this is assumed to be accurate, it falls short of precluding anticipation. An external agent which "permanently prevent[s] the operation of said in-vivo sensing device upon the satisfaction of a specified condition" would anticipate the claimed invention.

- [13] Applicant asserts without support that claim 19 is patentable over Denen in view of Kane. The rejection is maintained.

Conclusion

- [14] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

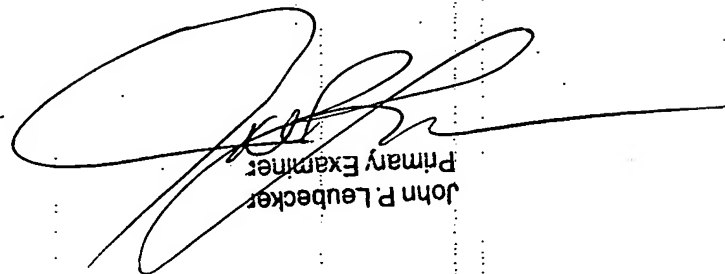
- [15] A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this

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final action.

- [16] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [17] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [18] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

[19] prs



John P. Leubecker
Primary Examiner